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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : T. TAKAHASHI

Group Art Unit: 2613

Appl. No. : 09/467,152

Examiner: Behrooz M. SENFI

Filed : December 20, 1999

For : ELECTRONIC ENDOSCOPE

**APPEAL BRIEF UNDER 37 C.F.R. § 1.192**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This appeal is from the Examiner's final rejection of claims 1, 3-10, 12-19, 21-23 and 25-31 as set forth in the Advisory Action of May 6, 2003.

A Notice of Appeal in response to the May 6, 2003 Advisory Action was filed June 13, 2003, along with a Request for a Two-month Extension of Time.

The requisite fee under 37 C.F.R. 1.17(c) in the amount of \$ 320.00 for the filing of the Appeal Brief, is being paid by check, submitted herewith. However, if for any reason the necessary fee is not associated with this file, the Commissioner is authorized to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 19-0089.

This appeal brief is being submitted in triplicate, pursuant to 37 C.F.R. 1.192(a).

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**(1) REAL PARTY IN INTEREST**

The real party in interest is PENTAX Corporation, by virtue of a Change of Name filed concurrently herewith including a Recordation Cover Sheet indicating that the name of original Assignee Asahi Kogaku Kogyo Kabushiki Kaisha has been changed to PENTAX Corporation, along with a copy of a Certificate of Corporate Resume and English language translation thereof (copy), and by virtue of an assignment recorded in the U.S. Patent and Trademark Office on December 20, 1999, at Reel 010471 and Frame 0382.

**(2) RELATED APPEALS AND INTERFERENCES**

No related appeals and/or interferences are pending.

**(3) STATUS OF THE CLAIMS**

Claims 1, 3-10, 12-19, 21-23 and 25-31, the only claims pending in the instant application, stand finally rejected.

**(4) STATUS OF THE AMENDMENTS**

On March 31, 2003, the Examiner issued an Advisory Action (Paper No. 10), indicating that Appellant's Amendment under 37 C.F.R. §1.116, filed March 13, 2003, would not be entered (as checked in box 2(a)) because the amendments therein raise new issues that would require further consideration and/or search. During a telephone call between Appellant's representative, Attorney William Boshnick and Examiner Senfi, it was noted that since each amended or new claim submitted in the Amendment merely included the

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limitations from a previously-submitted claim already considered by the Examiner, no new issues were raised in this Amendment.<sup>1</sup> In reply, the Examiner noted that the Advisory Action should have had box 2(d) checked instead of box 2(a), which indicates that the Amendment presents additional claims without canceling a corresponding number of finally-rejected claims.

Further to this telephone conversation, on April 14, 2003, Appellant submitted a second Amendment under 37 C.F.R. §1.116 (Paper No. 11), containing the same number of new claims as canceled finally-rejected claims. Specifically, finally-rejected claims 11 and 24 were canceled (totaling two canceled claims) and claims 30-31 were added (totaling two newly-added claims).

In reply to the second Amendment under 37 C.F.R. §1.116, the Examiner issued a second Advisory Action dated May 6, 2003 (Paper No. 12), noting that for purposes of Appeal, the proposed amendments will be entered and that an explanation of how the new or amended claims would be rejected would be provided, noting that claims 1, 3-10, 12-19, 21-23 and 25-31 stand finally rejected.

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<sup>1</sup> Specifically, in this Amendment independent claims 1 and 29 were amended to incorporate the limitations of canceled dependent claim 11, independent claim 19 was amended to incorporate the limitations of canceled dependent claim 24. Newly-added independent claims 30-32 respectively corresponded to newly-amended independent claims 1, 19 and 29, but further incorporated the limitations of previously-considered claim 12 (or similar claim 25).

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Concurrently with this Appeal Brief, Appellant is submitting herewith a third Amendment under 37 C.F.R. §1.116 to conform the dependency of claims 12 and 25 to depend from respective independent claims 1 and 19, rather than from respective canceled claims 11 and 24. Appellant discovered this apparent error in claim dependency during the preparation of the instant Appeal Brief. No amendment, other than the above third Amendment, has been filed subsequent to the second Advisory Action.

**(5) SUMMARY OF THE INVENTION**

The present invention is directed to an electronic endoscope in which the year, month, and day can be easily differentiated on a screen on which a date is output and displayed along with the image of the body cavity (Specification page 2, lines 21 - 24). The instant invention provides a data generating device, provided in an electronic endoscope, the device generating an image data corresponding to an object image obtained by the electronic endoscope, and character information including a date when the object image was obtained. The device includes a date-differentiating processor that generates the character information so that at least one of the year, month, and day is differentiated when the date is displayed on a screen of a display device along with the object image. Thus, when the date and the image, stored in an electronic file, are read therefrom and displayed on a screen of a display device, for example, several months or years after the recording date, at least one of the year, month, and day can be easily recognized by one viewing the screen. (Specification page 3, lines 1 - 13).

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In a first embodiment, a character signal is added to a video signal, output from image signal processor 21, at a predetermined timing. The character signal relates to character information, such as a date displayed on the monitor 49, shown in Fig. 1. On the screen of the monitor 49, the character information is displayed at a predetermined position along with the image of the body cavity S. The video signal of the body cavity S, along with the character signal, are output to the monitor 49, such that a moving image of the body cavity S is displayed in real time (Specification page 11, lines 3 - 11).

In a central processing unit (CPU) 30, information relating to the current date and time is read from a real time clock (RTC) 31. Then, character codes, corresponding to character information to be displayed, are transmitted to CRT controller (CRTC) 32. At this time, information relating to the positions, at which the character information is displayed on the screen of the monitor 49, is transmitted to the CRTC 32 as data. In the character code output to the CRTC 32, information relating to colors of the characters are included in this embodiment (Specification page 11, line 19 - page 12, line 7).

Fig. 2 is an example of a screen view displayed on the monitor 49. On the screen W, the image of the body cavity S is displayed in an image region I. Further, character information on the name of a patient Z1 examined, an ID number Z2 of the patient, his or her age Z3, gender Z4, name of the physician Z5 conducting the examination, name Z6 of the

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video-scope 10 connected, current date Z7, and time Z8 is displayed on the screen along with the image of the body cavity S (Specification page 13, lines 2 - 10).

The date is displayed by numerals in the order of the year, month, and day, so the date of examination becomes "December 13, 1998" on the screen W. Further, the coordinates (x, y) are set using the top left corner of the screen W as the origin (Specification page 13, lines 13 - 17).

Figs. 3A, 3B and 3C are partially enlarged views of screen examples on which dates Z7 are displayed in different orders of the year, month, and day. In the display A, shown in Fig. 3A, the date Z7A using the order of display mainly used in Japan is displayed. The "year" is displayed at the position of P1, the "month" at the position of P2, and the "day" at the position of P3. In this example, the year and day are displayed white and the month is displayed green to facilitate differentiation of the month and day (Specification page 13, line 21 - page 14, line 1).

In the display B, shown in Fig. 3B, the date using the order of display mainly used in the U.S. is displayed. The date Z7B is displayed in the order of the month, day, and year. Further, in the display C, shown in Fig. 3C, the date Z7C using the order of display mainly used in Europe is displayed. In this embodiment, the date is displayed on the screen W in the order of the day, month, and year. The order of the date may be changed by pressing f5 (function key) on the keyboard 26. At this time, in this embodiment, since the "day" and

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"month" are displayed in different colors, the date will never be misread even if the order is changed (Specification page 14, lines 2 - 12).

Further, as a result of this date differentiation of the present invention, it is easy for one viewing the display to distinguish between the month and the day and there is no chance of the date being misread even when reproducing and displaying the stored image of the body cavity S (Specification page 24, lines 2 - 6).

In another embodiment, when storing the image of a body cavity S in an image storage device 34, character codes corresponding to the year, month, and day of different colors are used, and the year, month, and day, displayed in different colors on the image storage and reproduction device 34, are stored. Due to this, when the image of a body cavity S is reproduced and displayed, differentiation of the year, month, and day becomes easy and there is no chance of misreading the stored date (Specification page 32, line 24 - page 33, line 8).

In the present invention, the colors and the fonts of the date displayed are set based on character code tables T and T' so as to facilitate at least determination of the month and day, but it is also possible to make just one of the year, month, and day a different color or font. For example, starting from 2000, if just the "year" is displayed on the screen W in a different color, the "year" can be determined from the displayed year, month, and day. When reproducing and displaying the stored image, it is possible to easily confirm the stored "year". In summary, according to the present invention, it is possible for one viewing the display to

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easily determine the year, month, and day from each other on a screen outputting and displaying the date along with the image of the body cavity (Specification page 33, line 20 - page 34, line 9).

**(6) ISSUES**

**(A) Whether claims 1, 3-12, 16-18, 29 and 30 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,846,155 to KIMURA (hereinafter KIMURA) in view of U.S. Patent No. 4,044,546 to KOIKE (hereinafter KOIKE).**

**(B) Whether claims 13-15, 19, 21-23, 25-28 and 31 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over KIMURA in view of KOIKE and further in view of U.S. Patent No. 5,408,996 to SALB (hereinafter SALB).**

**(7) GROUPING OF CLAIMS**

For the purpose of this appeal, Appellant submits that none of the claims stand or fall together. Therefore, each of claims 1, 3-10, 12-19, 21-23 and 25-31 are separately patentable for the reasons set forth hereinbelow.

**(8) ARGUMENT**

**(A) The Rejection of claims 1, 3-12, 16-18, 29 and 30 under 35 U.S.C. § 103(a) over KIMURA in view of KOIKE is in error, the decision to reject these claims on this ground should be reversed, and the application should be remanded to the Examiner.**

In the Final Official Action of December 13, 2002, the Examiner asserted that, regarding claims 1, 3-12, 16-18, 24 (now canceled) and 29, KIMURA “discloses [a] data generating device, provided in an electronic endoscope, [the] device generating an image



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data corresponding to an object image and character information including a date when said object image is obtained, and date differentiating process [*sic*, processor] that generates character information so that when date is displayed in a screen of a display device along with an object image, at least one of the year, month and day is differentiated on the screen, and storing and displaying mode on screen.” The Examiner further determined that while KIMURA “fails to explicitly teach color code or character type different from the others, KOIKE teaches displaying dates and months each in a different color, and that it would have been obvious to include this feature into the endoscope of KIMURA.”<sup>2</sup>

Appellant submits that none of the applied references teaches or discloses the claimed date-differentiating processor that generates character information so that, when the date is displayed on a screen of a display device along with said object image, at least one of the year, month, and day is differentiated on said screen. For Example, in KIMURA, while the date and image are displayable on the monitor 4, there is *no disclosure whatsoever* in KIMURA of differentiating one of the year, month and day of the date, contrary to the

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<sup>2</sup> On page 2, paragraph 2, lines 7-13 of the second Advisory Action (Paper No. 12) the Examiner correctly notes that he “does not conclude the teaching of Koike . . . to include this feature back into Koike.” Appellant notes that they erroneously indicated in their second Amendment under 37 C.F.R. §1.116 (Paper No. 11), page 6, last 4 lines, that “the Examiner has determined that KOIKE teaches displaying dates and months each in a different color, and concludes that it would have been obvious to include this feature into the device of KOIKE.” This sentence contains a clerical error, as it was Appellant’s intent in this Amendment to note that “the Examiner has determined that KOIKE teaches displaying dates and months each in a different color, and concludes that it would have been obvious to include this feature into the device of KIMURA.” Appellant appreciates the Examiner bringing this error to Appellant’s attention.

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Examiner's determination. Specifically, and as noted *supra*, in the Final Official Action, the Examiner asserted that this "date-differentiating" feature is present in KIMURA, but does not explain how the year, month and day are differentiated on the screen without a different character type or color (this different character type/color feature not being taught by KIMURA, as correctly noted by the Examiner). Thus, if the date in KIMURA is displayed as "01-10-03", without making the character type or color different, there is no way to distinguish the date from January 10, 2003, October 3, 2001, or March 10, 2001. However, in the present invention, for example, if the character type of the year is set in boldface type, and the month is set in italics, *e.g.* "**01**-10-03", then one reading the date would understand it to be October 3, 2001, no matter which date-order-convention is used in the world.

While in the Final Official Action the Examiner asserted that this "date-differentiating" feature is present in KIMURA, in the second Advisory Action, the Examiner noted that KOIKE "teaches differentiate [*sic*, differentiating] dates and months and color coding to distinguish between one another." Appellant respectfully submits that the Examiner is again mistaken in his assertion of the teaching of KOIKE. Specifically KOIKE is directed to a two-digit Liquid Crystal Display (LCD) timepiece. In KOIKE, since only two digits are displayed at a time, a date *cannot even be* displayed, let alone differentiated. Specifically, the Examiner noted (at page 3, line 5 of the second Advisory Action) that "displaying a date/birthday *must include* the year, month and day", and further noted (at page

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3, line 13 of the second Advisory Action) that “the use of ‘date/birthday’ (i.e. fig. 15) which *must include* at least one of the order of the ‘year, month and day; month, day and year; and day, month and year’ . . .” (emphasis added). Thus, based on the Examiner’s own conclusion, more than two-digits at a time must be displayed for these digits to form the date as defined in Appellant’s claims (*e.g.*, month day and year). Appellant notes that the term “date” is used in KOIKE to only describe the day (*see, e.g.*, col. 1, lines 54-56), and thus corresponds to the day of the date, as defined in Appellant’s claims. Therefore, contrary to the Examiner’s assertion (at page 3, line 1-2 of the second Advisory Action), KOIKE *does not* differentiate dates and months on the screen.

Thus, the applied references fail to teach or suggest the displaying of the date in an order of at least one of year, month and day; month, day and year; and day, month and year, wherein one of the year, month, and day is set to a color or character type different from the others, as claimed in independent claims 1, 19 and 29-31.

Appellant further respectfully submits that the Examiner is mistaken in his assertion in the Final Official Action that the preferred display order is not considered patentably significant. To the contrary, as noted in page 1, beginning line 15, of the specification of the present application, different parts of the world display the date in different order. For example, January 10, 2003 is displayed in the United States as 01-10-03, is displayed in Japan as 03-01-10, and is displayed in parts of Europe as 03-10-01. Given the international

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nature of medicine, as in certain instances medical records and procedures may be viewed in several countries to effect treatment, it is crucial that a doctor or other medical professional viewing the display in any given country, be given accurate information as to when a particular procedure was performed, for example, to track the progression of a disease. For example, a Japanese doctor viewing an image recorded from overseas may not know whether 01-10-03 designates January 10, 2003, October 3, 2001, or March 10, 2001.

The presently claimed invention differentiates at least one of the day, month and year of the date, from the other of the day, month and year. This differentiation is accomplished, for example, by displaying the year in a manner different from, for example, the day and month. For example, by displaying the year in a red color and the day in a blue color, a doctor reading the display will easily be able to distinguish the month, day and year from one another, regardless of their order of display on the screen.

To the contrary, as discussed *supra*, the endoscope of KIMURA merely displays the date on the screen (as noted by the Examiner in, *e.g.*, Fig. 15), and does not differentiate at least one of the day, month and year from each other. Thus, a doctor viewing the display of KIMURA may be confused as to which digits represent the year, month or day of the date, as described *supra*.

Further, also as discussed *supra*, KOIKE merely teaches a two-digit Liquid Crystal Display (LCD). According to KOIKE, a two-digit LCD is used to miniaturize the size of a

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timepiece, since such an LCD takes up less space than, for example, a four, six or eight digit LCD. Thus, since only a two digits of a date is displayed at a time on the screen (*i.e.*, the entire date is never displayed on the screen, as discussed *supra*), it is necessary to distinguish the two digits of the day, month and year (as well as hours, minutes and seconds) from each other, since the user would otherwise not know whether the day, month or year (or hours, minutes and seconds) is being displayed on the screen. KOIKE distinguishes between the two digits of the day, month, year, hours, minutes and seconds using color, since only two digits at a time are displayed on the screen. Additionally, as discussed *supra*, there is *no disclosure whatsoever* in KIMURA of differentiating one of the year, month and day of the date on the screen. Thus, KIMURA in combination with the alternating color-coding technique of KOIKE *does not* differentiate at least one of year, month and day on the screen, by setting one of the year, month, and day to a color or character type different from the others, as claimed in independent claims 1, 29 and 30. Thus, Appellant respectfully submits that these independent claims are patentably distinct from the references of record.

Further, with respect to Appellant's arguments that none of the applied references teaches or suggests the claimed switchably displaying an order of a date from *among* year, month and day; month, day and year; and day, month and year, as claimed in independent claims 30-31, the Examiner's response (in the second Advisory Action) that "as discussed above and based on the combination teaching of KIMURA in view of KOIKE, displaying

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an order of a date or changing the order of a date which is commonly well-known to a user at the particular location, is well-known in the prior art of record” completely fails to state a basis for such an assertion, as Appellant notes that neither KIMURA, KOIKE nor any other reference of record teaches switchably displaying an order of a date from *among* year, month and day; month, day and year; and day, month and year, as claimed in independent claim 30. Rather, the switching circuit 6 of KOIKE identified by the Examiner in the Final Official Action merely switches the two-digit display between minutes, hours, days and months (*See, e.g.,* col. 2, line 54 through col. 3, line 10). Since only a single item (*e.g.,* minutes, hours, days and months) is displayed at a time, no order of year, month and day can be displayed, let alone selectively displayed. It is thus respectfully submitted that for this additional reason, the Examiner’s rejection of independent claim 30 is improper and should be withdrawn.

Moreover, Appellant respectfully submits that the Examiner has not set forth a proper motivation as required by 35 U.S.C. § 103 to combine the teachings of KIMURA and KOIKE in the manner asserted by the Examiner. It is clear that in both rejections under §103, the Examiner has, based upon Appellant's disclosure, picked various individual features of the references and has combined them in the manner taught only by Appellant's disclosure. This hindsight reconstruction of the prior art is inappropriate under 35 U.S.C. § 103.

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Appellant submits that rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner has the initial duty of supplying the factual basis for the rejection and may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). As stated in W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984):

[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

In the second Advisory Action, the Examiner noted that in the second Amendment under 37 C.F.R. §1.116 (Paper No. 11) Appellant's "argument regarding 'the KOIKE reference is not directed toward an electronic endoscope, therefore is not combinable with Kimura reference' is not correct." To the contrary, Appellant did not make any such overly simplistic statement in the second Amendment, and were misquoted by the Examiner. Rather, Appellant noted that, as an example, the endoscope of KIMURA uses a video monitor 4, and is classified in class 600 (SURGERY), while the timepiece of KOIKE uses a two-digit Liquid Crystal Display (LCD), and is classified in class 368 (horology), and further noted that the KOIKE reference is not directed toward an electronic endoscope, but

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is rather directed toward an LCD timepiece. Appellant also noted in the second Amendment, that while KOIKE discloses the use of color to alternatingly differentiate different characters in a two-digit display, it relates to non-analogous art. As KOIKE is directed toward a two-digit LCD timepiece, this device lacks the necessary teaching with respect to specific recited features of Appellant's claims, and KOIKE fails to provide the subject matter noted above as deficient in KIMURA, and further fails to provide the necessary motivation for modifying the video monitor of KIMURA in any manner that would render unpatentable the instant invention. For example, there is no motivation to include a two-digit display such as a two-digit LCD into a video monitor. Accordingly, Appellant submits that no proper combination of KOIKE and KIMURA discloses or suggests the combination of features recited in at least independent claims 1, 29 and 30, and submits that the applied prior art fails to disclose or suggest the necessary motivation or rationale for a proper combination under 35 U.S.C. § 103(a).

With respect to the Examiner's rejection of dependent claims 3-10, 12 and 16-18 under 35 U.S.C. §103(a), as these claims are dependent from either allowable claim 1 or 19, the independent claims being allowable for at least the reasons discussed *supra*, these pending dependent claims are also allowable. Further, all dependent claims each set forth a further combination of elements neither taught nor disclosed by the applied references. For example none of the applied references teaches or suggests, alone or in any proper



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combination: that the date-differentiating processor sets one of the year, month, and day to a color or character type different from the others only for the period of a date-setting operation, as claimed in claim 3; that the date-differentiating processor sets a mode of display of the year, month, and day so that the screen differentiates at least one of the month and day, of the displayed year, month, and day, as claimed in claim 4; that the date-differentiating processor sets one of the month and day, of the year, month, and day displayed by numerals, to a different color, as claimed in claim 5; that the date-differentiating processor sets one of the month and day, of the year, month, and day, to a different character type, as claimed in claim 6; that the date-differentiating processor sets the month, of the year, month, and day, as letters, as claimed in claim 7; that the date-differentiating processor sets one of the month and day, of the year, month, and day displayed by numerals, to a different font, as claimed in claim 8; that the date-differentiating processor sets one of the month and day, of the year, month, and day to be displayed by numerals, to a different color only for the period of the date setting operation, as claimed in claim 9, that the date-differentiating processor sets the year, month, and day to be displayed by numerals to respectively different colors, as claimed in claim 10; that the display order can be changed on the screen by a switching operation of the display order, as claimed in claim 12; the display processor that displays the character information, generated by the date-differentiating processor, along with the object image, on the screen, as claimed in claim 16; that the display processor comprises a character code

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output processor that outputs a character code corresponding to the date, and a character signal generating processor that generates a character signal in accordance with the character code output by the character code output processor, the character signal being output, along with a video signal corresponding to the object image, to a monitor provided outside the electronic endoscope, so that the object image is displayed on the screen and the date is displayed at a predetermined position on the screen, as claimed in claim 17; and that the date-differentiating processor outputs the character code in such a manner that one of the year, month, and day, to be differentiated from the others, is displayed in a mode of display which is different from that of the others, as claimed in claim 18.

Accordingly, Appellant respectfully submits that the Examiner's final rejection of claims 1, 3-12, 16-18, 29 and 30 under 35 U.S.C. § 103(a) is improper for all the above reasons and respectfully requests that the Examiner's decision to reject these claims on this ground be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over KIMURA and KOIKE and an early allowance of all claims on appeal.

**(B) The rejection of claims 13-15, 19, 21-23, 25-28 and 31 under 35 U.S.C. § 103(a) over KIMURA in view of KOIKE and further in view of SALB is in error, the decision to reject these claims on this ground should be reversed, and the application should be remanded to the Examiner.**

In the Final Official Action, the Examiner asserted that, regarding claims 13, 14, 19 and 26, that the combination of KIMURA and KOIKE teaches an "electronic endoscope, and displaying a year, month and day of a date along with an object image on a screen and

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different color or character type and stores date [*sic*] along with said object image”, but fails to explicitly teach the storing processor that stores the date along with the object image as a single image. However, the Examiner determined that SALB teaches displaying dates and the object image as a single image, and concluded that it would have been obvious to include this feature into the combination KIMURA and KOIKE.

Appellant respectfully traverses the Examiner’s rejection for at least the reasons discussed with respect to item (A), *supra*. For example, the applied references fail to teach or suggest a storing processor that differentiates at least one of year, month and day of the date, as claimed in independent claim 19. As discussed *supra*, there is no disclosure in KIMURA of differentiating one of the year, month and day of the date, and the two-digit LED display of KOIKE is incapable of differentiating a date. Thus, Appellant respectfully submits that independent claims 19 and 31, as well as all independent claims, are patentably distinct from the references of record for at least these reasons.

Additionally, with respect to the Examiner’s rejection under 35 U.S.C. § 103(a) (based on KIMURA in view of KOIKE and further in view of U.S. Patent No. 5,408,996 to SALB), the Examiner has again not set forth a proper motivation as required by 35 U.S.C. § 103 to combine the teachings of the references in the manner asserted by the Examiner, as it appears that the Examiner has taken the above-noted improper (KIMURA-KOIKE) combination and

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again inappropriately and randomly combined it with another reference (SALB), to arrive at the invention as recited in Appellant's claims 13-15, 19, 21-23, 25-28 and 31.

Additionally, while the Examiner has correctly asserted that KIMURA and KOIKE fail to teach a storing processor that stores the date along with the object image as a single image, the Examiner has failed to assert that SALB teaches such a claimed storing limitation. Rather, the Examiner has asserted that SALB teaches displaying dates and the object image as a single image. Appellant notes that while SALB may appear to store and display the object image, SALB completely fails to disclose the claimed storing processor that stores the date along with the object image in an image storage device as a single image, as claimed in independent claim 19. In fact, SALB completely fails to disclose the storing of dates at all. Thus, no proper combination of KOIKE, KIMURA and SALB can render unpatentable the combination of features recited in at least independent claims 19 and 31.

Further, as discussed *supra*, with respect to Appellant's arguments that none of the applied references teaches or suggests the claimed switchably displaying an order of a date from *among* year, month and day; month, day and year; and day, month and year, as claimed in independent claims 30-31, the Examiner's response (in the second Advisory Action) that "as discussed above and based on the combination teaching of KIMURA in view of KOIKE, displaying an order of a date or changing the order of a date which is commonly well-known to a user at the particular location, is well-known in the prior art of record" completely fails

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to state a basis for such an assertion, as Appellant notes that neither KIMURA, KOIKE nor any other reference of record teaches switchably displaying an order of a date from *among* year, month and day; month, day and year; and day, month and year, as claimed in independent claim 30. Rather, also as discussed *supra*, the switching circuit 6 of KOIKE identified by the Examiner in the Final Official Action merely switches the two-digit display between minutes, hours, days and months (*See, e.g.*, col. 2, line 54 through col. 3, line 10). Since only a single item (*e.g.*, minutes, hours, days and months) is displayed at a time, no order of year, month and day can be displayed, let alone selectively displayed. It is thus respectfully submitted that for this additional reason, the Examiner's rejection of independent claim 31 is also improper and should be withdrawn.

With respect to the Examiner's rejection of dependent claims 13-15, 21-23 and 25-28 under 35 U.S.C. §103(a), as these claims are dependent from either allowable claim 1 or 19, the independent claims being allowable for at least the reasons discussed *supra*, these pending dependent claims are also allowable. Further, each dependent claim sets forth a further combination of elements neither taught nor suggested by the applied references. For example none of the applied references teaches or suggests, alone or in any proper combination: that the object image and date to be displayed on the screen are stored as a single image in an image storage device, as claimed in claim 13; that the object image stored in the image storage device is at least reproduced and displayed on the screen or output as

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hard copy, as claimed in claim 14; the storing processor that stores the date along with the object image, in an electronic file, as claimed in claim 15; that the storing processor stores the year, month, and day in the image storage device to enable at least the month and day in the year, month, and day to be differentiated on the screen, as claimed in claim 21; that the storing processor stores one of the month and day in the year, month, and day by a different color or different character type in the image storage device, as claimed in claim 22; that the storing processor stores the year, month, and day displayed by numerals by different colors in the image storage device, as claimed in claim 23; that the display order can be changed on the screen by a switching operation of the display order, as claimed in claim 25; that the image stored in the image storage device is at least reproduced and displayed on the screen or output as hard copy, as claimed in claim 26; that the storing processor comprises a character code output processor that outputs a character code corresponding to the date, and a character signal generating processor that generates a character signal in accordance with the character code output by the character code output processor, the character signal being output, along with a video signal corresponding to the object image, to the image storage device, so that the date is stored in the image storage device along with the image, as claimed in claim 27; and that the storing processor outputs the character code in such a manner that one of the year, month, and day, to be differentiated from the others, is displayed in a mode of display which is different from that of the others, as claimed in claim 28.

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Therefore, in view of the foregoing, Appellant submits that the applied prior art fails to disclose or suggest the requisite motivation or rationale for proper combination under 35 U.S.C. § 103(a). Moreover, Appellant submits that any proper combination of KIMURA, KOIKE and/or SALB fails to disclose or suggest the combination of features recited in at least independent claims 19 and 31.

Accordingly, Appellant respectfully submits that the Examiner's final rejection of claims 13-15, 19, 21-23, 25-28 and 31 under 35 U.S.C. § 103(a) is improper for all the above reasons and respectfully requests that the Examiner's decision to reject these claims on this ground be reversed, and that the application be remanded to the Examiner for withdrawal of the rejection over KIMURA in view of KOIKE and further in view of SALB and an early allowance of all claims on appeal.

**(D) Conclusion**

Claims 1, 3-12, 16-18, 29 and 30 are patentable under 35 U.S.C. § 103(a) over any proper combination of the teachings of KIMURA and KOIKE, and claims 13-15, 19, 21-23, 25-28 and 31 are patentable under 35 U.S.C. § 103(a) over any proper combination of the teachings of KIMURA, KOIKE and SALB. Specifically, the applied art of record fails to disclose or suggest the unique combination of features recited in Appellant's claims 1, 3-10, 12-19, 21-23 and 25-31 for at least the reasons noted *supra*. Accordingly, Appellant respectfully requests that the Board reverse the decision of the Examiner to reject claims 1,

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3-10, 12-19, 21-23 and 25-31 under 35 U.S.C. § 103(a) and remand the application to the Examiner for withdrawal of the rejection.

Thus, Appellant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 103(a), and that the present application and each pending claim are allowable over the prior art of record.

Respectfully submitted,  
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Attachments:      Appendix A: Claims on Appeal, *i.e.*, Claims 1, 3-10, 12-19, 21-23 and 25-31.